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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,810	02/17/2000	Kyoko Kawaguchi	32410	7331

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EXAMINER

BASHORE, ALAIN L.

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/505,810

Applicant(s)

KAWAGUCHI ET AL.

Examiner

Alain L. Bashore

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2000 and 07 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 14-19, 23-30, 32-37, 39-46 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 9-13, 20, 22, 31, 38, 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-17-00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to because:

- a) foreign language is present in the drawings. Applicant is reminded not to add new matter to the drawings. Any change of a foreign word to English word without any other support already in English, in the specification as originally filed, will require a certified translation of that particular word or words;
- b) the last four drawing pages (sheets 14-17) submitted do not contain drawings;
- c) shading is not permitted
- d) Figures 13 and 14 should be designated by a legend such as –Prior Art-- because only that which is old is illustrated. Applicant has described both drawing figures as “existing” systems, which has therefore raised this issue. If these drawing figures are not prior art, applicant must clearly explain why they are not on the record. See MPEP § 608.02(g).

3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the reference on page 3 have been cited by the examiner on form PTO-892, they have not been considered.

5. The specification is objected to under MPEP 608.01c because there is no sub-section for the field of the invention. A specific sub-section entitled: "FIELD OF INVENTION" is required within the background of the invention.

6. The specification is objected to under MPEP 608.01d because the brief summary of the invention is not brief. A summary that encompasses page 9 through part of page 38 is not considered brief.

7. The disclosure is objected to because of the following informalities: reference characters described on pages 2-5 give two reference numbers, one in parentheses. Appropriate correction is required.

8. Claims 9-13, 20, 22, 31-32, 38, 47 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim dependent on another multiple dependant claim. See MPEP § 608.01(n). Accordingly, the claims 9-12, 20, 22, 31, 38, 47 have not been further treated on the merits. Claim 13 and 32 are also considered improper (since it is dependent on an improper multiple dependant claim), and therefore will not also be further treated on the merits.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8, 13-19, 21, 23-30, 32-37, 39-46, 48-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons:

a) The claims appear to contain certain literal translations into English from a foreign document and contain grammatical and idiomatic errors. Examples include: "is at hand" in claim 7 and 53, "very close at hand" in claim 7 and 48, "is close at hand" in claim 8 and 48, "in a case where" in claim 4, 26 and 30, "in a case" in claim 14, "on time" in claim 17, "is disposed to be stationary" in claims 4 and 26, thus-issued" in claim 14, "forcibly transmits" in claims 8 and 48, "forcibly transmitting in claim 30 and 49.

b) Claims 3, there is recited the following limitations which have insufficient antecedent basis in the claims:

Claim 3: "the electronic ticket"

Claim 4: "the terminal" since there is now claimed two types of terminals,

Claim 38: "the event"

Claim 40: "the user's right"

Claim 41: "the electronic ticket"

c) The claims are confusing since the language recited regarding the movement of the certificate and the electronic asset is not clear. For example: claims 45 and 46: "when an exchange certificate is submitted to the server by way of the communications network" is confusing since both certificate and asset are within the same server. Suggestion: there is a problem regarding recitations of the certificate being claimed the same even through it has different characteristics, i.e. before it sent to the terminal and after returning from the terminal. Please claim the pathways clearly. In claim 51, there is recited "at least one of" and then there is recited "and" which is confusing.

11. Claims 1-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is claimed an "electronic asset" and it is unclear as to the metes and bounds of this recitation. On page 41 of applicant's

specification the term is described to "compressively encompasses" certain embodiments. It is not clear if this is a limitation to specific embodiments or is merely describing illustrative examples. To overcome this rejection, applicant must clearly state on the record what is meant by "compressively encompasses".

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8, 14-19, 21, 23-30, 32, 39-46, 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Goldschlag et al.

Williams et al. discloses an electronic utilization system and method. A terminal outputs a signal for a desired electronic asset (as an instruction or request step).

The signal is for instructing transmission of a desired electronic asset. The signal can be for settling a charged bill to a desired electronic asset. A server transmits the desired electronic asset to the terminal or to another predetermined terminal (as an electronic asset transmission step). The server further includes: settlement processing means (and settlement step), issuance means (and issuance step) that issue a certificate, processing means (and certificate transmission step) which transmits the certificate issued by the issuance means to the terminal. The terminal is a portable

mobile terminal. The terminal displays the message or content of the certificate. An expiration date is also utilized for the certificate.

With respect to the claimed recitation of the terminal generates a sound, it is the examiner's position that this is conventional per se in the art, and therefore would be obvious to one with ordinary skill in the art to include to Williams et al.

Williams et al. does not explicitly disclose the certificate is an exchange certificate which comprises settlement information and status information.

Goldschlag et al. discloses an exchange certificate which comprises settlement information and status information. It is the examiner's position that it would have been obvious to one with ordinary skill in the art to include the above to Williams et al. because both Williams et al and Goldschlag et al teach settlement methods for electronic assist utilization, and Goldschlag et al teaches convenience for electronic transactions.

14. Claims 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over William et al in view of Goldschlag et al. as applied to claims 1-8, 14-19, 21, 23-30, 32, 39-46, 48-53 above, and further in view of Walker et al.

William et al in view of Goldschlag et al. does not explicitly disclose requesting booking of a desired electronic asset.

Walker et al. discloses requesting booking of a desired electronic asset. It is the examiner's position that it would have been obvious to one with ordinary skill in the art

to include the above to Williams et al in view of Goldschlag et al. because Walker et al. and Williams et al. in view of Goldschlag et al teach electronic assist utilization.

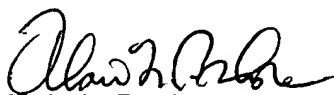
Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Robinson et al, Maher, Sirbu et al., Roweney et al. and Osamu (JP40930566A) all teach electronic asset utilization..

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Alain L. Bashore
January 9, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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